

SEKI *et al.*, SN 10/076,566  
Amdt. filed 10/28/2004  
Reply to OA dated 7/28/2004

500.41209X00/W0138-01EF  
Page 10

### REMARKS

This Amendment is responsive to the Office Action identified above, and is further responsive in any manner indicated below.

### REPLACEMENT TITLE

The title was objected to because of the Office Action concerns listed within Item 1 on page 2, *i.e.*, as not being sufficiently descriptive. Applicant has adopted the title suggested by the Examiner in the Office Action, and Applicant and the undersigned thank the Examiner for such consideration. In the event that the present replacement title is itself found not to be sufficiently descriptive, the Examiner is herein authorized to amend to a suitable replacement title.

### PENDING CLAIMS

Claims 1-8 were pending for examination and consideration in the noted application. Unrelated to any prior art, scope adjustment or rejection, appropriate claims have been amended or added in order to adjust a clarity and/or focus of Applicant's invention. That is, all such changes are simply clarified claims in which Applicant is presently interested. At entry of this paper, Claims 1-12 are pending for consideration and examination in the present application.

### REJECTIONS UNDER 35 USC §§102 AND 103 - TRAVERSED

All 35 USC rejections (*i.e.*, the §102 rejection of Claims 1-5 and 8 as being anticipated by Li (US 6,480,843 B2); and the §103 rejection of Claims 6 and 7 as

SEKI *et al.*, SN 10/076,566  
Amdt. filed 10/28/2004  
Reply to OA dated 7/28/2004

500.41209X00/W0138-01EF  
Page 11

being unpatentable over Li in view of Selvarajan *et al.* (US 6,279,033 B1)) are respectfully traversed. Such rejection has been rendered obsolete by the present clarifying amendments to Applicant's claims, and accordingly, traversal arguments are not appropriate at this time. However, Applicant respectfully submits the following to preclude renewal of such rejection against Applicant's clarified claims.

All descriptions of Applicant's disclosed and claimed invention, and all descriptions and rebuttal arguments regarding the applied prior art, as previously submitted by Applicant in any form, are repeated and incorporated herein by reference. Further, all Office Action statements regarding the prior art rejections are respectfully traversed. As additional arguments, Applicant respectfully submits the following.

At the outset, as to the requirements to support a rejection under 35 USC §102, reference is made to the decision of *In re Robertson*, 49 USPQ2d 1949 (Fed. Cir. 1999), wherein the Court pointed out that anticipation under 35 USC §102 required that each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. As noted by the Court, if the prior art reference does not expressly set forth a particular element of the claim, that reference still may anticipate if the element is "inherent" in its disclosure. To establish inherency, the Court pointed out that inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

With regard to the requirements to support a rejection under 35 USC §103, reference is made to the decision *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988),

SEKI *et al.*, SN 10/076,566  
Amdt. filed 10/28/2004  
Reply to OA dated 7/28/2004

500.41209X00/W0138-01EF  
Page 12

wherein the court pointed out that the PTO has the burden under §103 to establish a *prima facie* case of obviousness, and can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would motivate that individual to combine the relevant teachings of the references. As noted by the Court, whether a particular combination might be "obvious to try" is not a legitimate test of patentability and obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination.

Furthermore, such requirements have been clarified in the recent decision in *In re Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002), wherein the Court, in reversing an obviousness rejection, indicated that deficiencies of the cited reference cannot be remedied with conclusions about what is "basic knowledge" or "common knowledge."

The Court pointed out:

The Examiner's conclusory statements that "the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software" and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial" do not adequately address the issue of motivation to combine. This factual question of motivation is immaterial to patentability, and could not be resolved on subjected belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of reference, simply to "[use] that which the inventor taught against its teacher."...Thus, the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion. (emphasis added)

SEKI *et al.*, SN 10/076,566  
Amdt. filed 10/28/2004  
Reply to OA dated 7/28/2004

500.41209X00/W0138-01EF  
Page 13

Therefore, in order to properly support a §102 anticipation-type rejection, the reference must teach the specific limitations of the claimed invention. In order to properly support a §103 obviousness-type rejection, the reference not only must suggest the claimed features, but also must contain the motivation for modifying the art to arrive at an approximation of the claimed features. However, the cited art does not adequately support either a §102 anticipation-type rejection or a §103 obviousness-type rejection because it does not, at minimum, disclose (or suggest) the following discussed limitations of Applicant's claimed invention.

More particularly, Applicant's disclosed and claimed invention is directed toward arrangements (devices, methods, systems, etc.) attempting to increase an efficiency in executing retrieval processes from a large number of databases on a network. In order to accomplish the same, Applicant's disclosed and claimed arrangements compare differing (user-requested) retrieval requests to check for duplicates in the requests. In the event of duplicates, duplicating requests are combined to generate an integrated retrieval request which serves to effect a singular retrieval process, rather than multiple redundant retrieval processes. Applicant's disclosed and claimed invention also accomplishes other advantages, such as making duplicates of retrieval results and editing each of the same to satisfy the original retrieval requests.

Turning now to rebuttal of the applied art, the primary LI reference is directed to a wholly differing invention/objective. More particularly, LI appears to focus on a single request (rather than multiple potentially duplicate-containing requests), and in short, expands a query in the single request using semantically similar and

SEKI *et al.*, SN 10/076,566  
Amdt. filed 10/28/2004  
Reply to OA dated 7/28/2004

500.41209X00/W0138-01EF  
Page 14

syntactically related words for the purpose of reducing the chances of missing relevant documents. Hence, LI has no concern with combining duplicates from differing requests.

The secondary Selvarajan *et al.* reference does not cure the major deficiency mention above with respect to the primary Li reference.

In addition to the foregoing, the following additional remarks from Applicant's foreign representative are also submitted in support of traversal of the rejection and patentability of Applicant's claims.

This invention aims at reserved retrieval in which duplicates in retrieval processing and sending of retrieval results are eliminated to effect efficient retrieval.

To this end, if there are duplicates in a plurality of retrieval requests registered, the duplicative requests are integrated into an integrated request and information is retrieved from a database using the integrated retrieval request to make a copy of the retrieval results, and the copied retrieval results are edited on the basis of the respective registered retrieval requests by users to output the edited results to the users.

In another aspect of the invention, to a user who has registered a plurality of retrieval requests, duplicates in retrieval results to respective retrieval requests are integrated, and an integrated retrieval result is outputted.

The patent to LI relates to a method and apparatus for effecting query expansion by replacing semantically similar and syntactically related keywords with associated ones of the higher granularity concepts (expanded in concept) in the query to reduce the chances of missing relevant documents and effecting retrieval

SEKI *et al.*, SN 10/076,566  
Amdt. filed 10/28/2004  
Reply to OA dated 7/28/2004

500.41209X00/W0138-01EF  
Page 15

using the replaced keywords. Thus, Li integrates synonymous keywords into conceptually other keywords.

To the contrary, the present invention integrates queries by deleting (removing) duplicative keywords contained in a plurality of retrieval requests. Therefore, the present invention differs from the Li patent in purpose of integration and scheme for integration.

The patent to Selvarajan *et al.* discloses that, in order to reduce the workload for report sending, when a user requests a report the system creates a report request list and checks whether or not one similar to the request already has been made. If the request is new, the report corresponding to the request is added to the report request list. If the report already has been requested, only the request is added to the list.

Accordingly, Selvarajan *et al.* tries to eliminate a duplicate in reports sent in the past on the basis of an entered report request and the report request list, whereas the present invention eliminates a duplicate contained in retrieval results being currently sent to a user.

Thus, the present invention differs from Selvarajan *et al.* in object under determination of a duplicate. Therefore, this patent could not be applicable to this invention.

Even with combination of Li and Selvarajan *et al.*, this invention as specified and clarified in the amended claims would not be obvious.

As a result of all of the foregoing, it is respectfully submitted that the applied art would not support a §102 anticipatory-type rejection of Applicant's claims.

SEKI *et al.*, SN 10/076,566  
Amdt. filed 10/28/2004  
Reply to OA dated 7/28/2004

500.41209X00/W0138-01EF  
Page 16

Accordingly, reconsideration and withdrawal of such §102 rejection, and express written allowance of all of the §102 rejected claims, are respectfully requested.

#### **EXAMINER INVITED TO TELEPHONE**

The Examiner is invited to telephone the undersigned at the local D.C. area number of 703-312-6600, to discuss an Examiner's Amendment or other suggested action for accelerating prosecution and moving the present application to allowance.

#### **RESERVATION OF RIGHTS**

It is respectfully submitted that any and all claim amendments and/or cancellations submitted within this paper and throughout prosecution of the present application are without prejudice or disclaimer of any scope or subject matter. Further, Applicant respectfully reserves all rights to file subsequent related application(s) (including reissue applications) directed to any/all previously claimed limitations/features which have been subsequently amended or cancelled, or to any/all limitations/features not yet claimed, *i.e.*, Applicant continues (indefinitely) to maintain no intention or desire to dedicate or surrender any limitations/features of subject matter of the present application to the public.

#### **CONCLUSION**

This Amendment is being submitted within the shortened statutory period for response set by the Office Action mailed 28 July 2004, and therefore, no Petition is required. To whatever other extent is actually necessary and appropriate, Applicant

SEKI *et al.*, SN 10/076,566  
Amdt. filed 10/28/2004  
Reply to OA dated 7/28/2004

500.41209X00/W0138-01EF  
Page 17

respectfully petitions for an appropriate extension of time under 37 CFR §1.136.

The Form PTO-2038 attached hereto authorizes payment of the requisite additional claims fee. Please charge any actual deficiency in fees to ATSK Deposit Account No. 01-2135 (as Case No. 500.41209X00).

Respectfully submitted,



Paul J. Skwierawski  
Registration No. 32,173  
ANTONELLI, TERRY, STOUT & KRAUS, LLP  
1300 North Seventeenth Street, Suite 1800  
Arlington, Virginia 22209-3801, USA  
Telephone 703-312-6600  
Facsimile 703-312-6666

Attachment:  
Form PTO-2038 (Fee Code 1201)